

Remarks/Arguments:

The pending claims are 37, 40, 41, 44, 47, 59, 66, 69, 70, 73, 76.

Applicants acknowledge with thanks the courtesy extended to their representative during the telephone interview of August 11, 2005. Claims 37 and 66 were discussed in view of the cited prior art. The Examiner agreed claims 37 and 66 are similar. No agreement was reached.

Claims 37, 40, 41, 44, 47, 59, 66, and 76 have been rejected under 35 U.S.C. § 102(b) as anticipated by Nakatani et al. (U.S. Patent No. 6,096,411). The rejection is respectfully traversed.

Claim 37 recites, in part:

resin material impregnated into the fiber sheet, the resin material including at least one of thermoplastic resin and thermosetting resin having semi-cured portion; and

a resin layer formed smoothly on the fiber sheet, the resin layer being made of material identical to the resin material.

Claim 66 recites, in part:

resin material impregnated into the fiber sheet, the resin material including at least one of thermoplastic resin and thermosetting resin having semi-cured portion; and

a resin layer formed on the fiber sheet, being made of material identical to the resin material.

With respect to claim 37, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Nakatani does not anticipate claim 37. Figure 3A discloses copper foils 4, 4 deposited on the outsides of fiber sheets 10, 10. Figure 3A does not disclose "a resin layer formed on the fiber sheet" 10, as required by claim 37. For this reason alone, claim 37 is not subject to rejection under 35 U.S.C. § 102(b) as anticipated by Nakatani because Nakatani does not disclose all of the features recited in claim 37.

In addition, applicants respectfully submit that part of paragraph 5 of the Office Action's explanation of the basis for the § 102(b) rejection of claim 37 is wrong under United States patent law. This paragraph states, in part:

Applicants conclude that such lack of teachings by the reference along with the admitted concession, the invention is not anticipated. The examiner disagrees. It would have been obvious to substitute such argued material in the reference for it has long being [sic] held that the selection of known material on the basis of its suitability for the intended use is a mere obvious matter of design choice.

In effect, the Office Action contends that claim 37 is anticipated because it would have been obvious to substitute a resin layer for copper foils. Such a contention is not supported by U.S. Patent Law. Since the Office Action has erroneously based its anticipation rejection upon the contention that it would have been obvious to substitute a resin layer for a copper foil, claim 37 is not subject to rejection under 35 U.S.C. § 102(b) as anticipated by Nakatani.

In addition, dependent claims 40, 41, 44, 47, 59 are also not subject to the same rejection.

As shown above, independent claim 66 has virtually the same recitation as claim 37. Accordingly, all of the above arguments also apply to the § 102(b) rejection that has been applied to claim 66 and to dependent claim 76. Therefore claims 66 and 76 are also not subject to rejection under 35 U.S.C. § 102(b) as anticipated by Nakatani.

Claims 66, 69, 70, 73 and 76 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Nakatani. The rejection is respectfully traversed. Paragraph 5, on page 3 of the Office Action contends that it would have been obvious to substitute resin material for the copper foil disclosed in Nakatani. Applicants respectfully disagree. In Nakatani, copper foils 4, 4 serve as electrodes to provide electric connection. (col. 8, lines 45-47). That is, the Nakatani device must have copper foils 4, 4 in order to function. If resin layers are substituted for the copper foils in Nakatani, the Nakatani device would no longer function as a printed circuit board. Therefore, it would not have been obvious to one skilled in the art to substitute resin material for the copper foils in the Nakatani device.

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The claimed device is an improvement over the device in Nakatani. Using a resin layer on the fiber sheet that is formed from the same material as the resin material impregnated into the fiber sheet allows the resin layer to be smooth. Increased smoothness prevents short circuits between adjacent circuit patterns formed by etching metal foil selectively. (page 6, line 27-page 7, line 8).

For the above reasons, claims 66, 69, 70, 73 and 76 are not subject to rejection under 35 U.S.C. § 103(a) as unpatentable over Nakatani.

In view of the above contentions, all of the pending claims are now in condition for allowance.

Respectfully submitted,

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